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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/550,189

07/13/2006

Naum Simanovsky

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03/03/2008

NATH & ASSOCIATES
112 South West Street
Alexandria, VA 22314

EXAMINER

SIGLER, JAY R

ART UNIT

PAPER NUMBER

3733

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/550,189	Applicant(s) SIMANOVSKY, NAUM	
	Examiner JAY R. SIGLER	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 14-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10 October 2006 and 18 August 2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Invention I, claims 1-13, in the reply filed on 03 January 2008 is acknowledged.
2. Claims 14-21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 03 January 2008.

Priority

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

4. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are: "deviation of normal spine" (p. 1, l. 5); "may rich up to" (p.1, l. 10); "explains term of Idiopathic" (p. 1, l. 11); "cosmetic complains" (p. 1, l. 13); "Apart from congenital scoliosis, which is caused by congenital anomalies of spinal structure, for idiopathic type of scoliosis no congenital anomalies of vertebrae or rib cage are identified" (p. 1, ll. 16-18).

5. A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.

Claim Objections

6. Claim 7 and 8 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

10. In claim 3, line 4 and claim 5, line 5 and 6, "immobilizer" and "immobilize" are misdescriptive because as disclosed it would appear that the linear plate is capable of

being mobile within the anchor at least to some degree (immobile taken as incapable of moving or being moved. immobile. (n.d.). *Dictionary.com Unabridged (v 1.1)*. Retrieved February 26, 2008, from Dictionary.com website:

<http://dictionary.reference.com/browse/immobile>). Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999).

11. Claim 5 recites the limitation "the immobilizer" in line 6. There is insufficient antecedent basis for this limitation in the claim. Claim 5 should depend from claim 3 instead of claim 2 in order to provide proper antecedent for "the immobilizer" and will be considered as such for examination purposes.

12. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claim 1-4, 6-11, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Martin (US 5,672,175). Martin teaches:

a. Concerning claim 1: an implant useful for treating rotational malfunction of the spinal column wherein said device is capable of applying pure rotational progressive forces (see Abstract), comprising;

i. a linear plate (4a or 4b) having a longitudinal axis adapted to exceed from an apex of the upper scoliotic curve to an apex of the lower scoliotic curve (col. 8, ll. 46-50; embodied by treating a deformation of the scoliotic type), having predetermined axial dynamic de-rotational properties (col. 9, ll. 22-24), having a spring- like means to torque in axial plate (col. 9, ll. 6-13; embodied by elastic bending forces or elements 21-24) and permitting free movements in coronal, longitudinal and/or sagittal directions (col. 9, ll. 6-13; embodied by allowing physiological movements);

ii. at least two anchors (55) interconnecting said plate with the spinal column, each of said anchors having proximal and distal portions;

(1) said proximal portion (area of 5a or 5b) is having means (5a or 5b) to be reversibly affixed on any position along the longitudinal axis of said plate (col. 9, ll. 53-61);

(2) said distal portion (area of 61 and 71) having a connecting means to entrap the spinal column in at least two locations (col. 16, ll. 23-26; Fig. 11; screw 61 and hook 71); and

- iii. clasp means (65), adapted to effectively clasp the spinous process portion of the spinal column (seen in Fig. 8).
- b. Concerning claims 2-4, 6-11, and 13: anchors have anchor parts comprising a grip (threaded portion of screw 61 or hooked portion of hook 71) and base part (head of screw 61 or head of hook 71) and a triangular shaped base (55 taken to be triangular shaped); 8 or 29 can be seen as immobilizers in the sense used by applicant; the arched surfaces of the clamps of 65 can be seen as u-shaped; the anchors are hook-like members or screw-like members; the implant is adapted for correcting of Idiopathic Scoliosis (col. 3, ll. 6-8) and to exceed from an apex of the upper scoliotic curve to an apex of the lower scoliotic curve (col. 8, ll. 46-50; embodied by treating a deformation of the scoliotic type); capable of treating idiopathic scoliosis have 3 apexes where there are 3 sets of anchors and 2 linear plates (see Fig. 1); the plates are rod-like; the plates are made of stainless steel or a composite material (col. 8, ll. 63-66); a portion of the anchors can be seen as is described in figures 3 or 4 of the instant application.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US 5,672,175). Martin teaches the claimed invention including curved protruded grips

(embodied by each side of collar shaped 31) with means 32 to immobilize the immobilizers 29, but not specifically that there is a width between the grips about 1mm more than the width of the linear plate. With regard to this limitation, it would have been obvious to one having ordinary skill in the art at the time the invention was made to allow a width between the grips about 1 mm more than the width of the linear plate in the invention of Martin, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

17. Claim 12 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Martin (US 5,672,175). With regard to the method step recitation in claim 12, "wherein the moment force is tailor made by the physician and ranges from about 5 to about 150 lbs per cm", it is noted that the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation has not given patentable weight.

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 for other pertinent art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAY R. SIGLER whose telephone number is (571)270-3647. The examiner can normally be reached on Monday through Thursday from 8 AM to 4 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JRS/

/Eduardo C. Robert/
Supervisory Patent Examiner, Art Unit 3733